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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SINPEI NAKATA, TAKEHIDO YOTSUGI, and
HIROAKI ISHIZAWA

Appeal No. 2009-009058
Application No. 09/936,918
Technology Center 1700

Oral Hearing Held: November 19, 2009

Before BRADLEY R. GARRIS, CHUNG K. PAK, and PETER F. KRATZ,
Administrative Patent Judges.

ON BEHALF OF THE APPELLANT:

GENE W. STOCKMAN, ESQUIRE
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1 The above-entitled matter came on for hearing on Thursday,
2 November 19, 2009, commencing at 9:38a.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before
4 Dawn A. Brown, Notary Public.

5 THE USHER: Calendar Number 66, Mr. Stockman.

6 JUDGE GARRIS: Thank you. Good morning, Mr. Stockman.

7 MR. STOCKMAN: Good morning, Your Honors.

8 THE COURT: Sir, I wonder if you would have a business card you could give
9 to our reporter to help her out.

10 MR. STOCKMAN: Absolutely.

11 JUDGE GARRIS: All right. Mr. Stockman, we have discussed your case
12 prior to the hearing, so we're familiar with it. With that in my mind --

13 MR. STOCKMAN: I'm sorry, sir. I couldn't hear you.

14 JUDGE GARRIS: I was saying that we have discussed your case prior to the
15 hearing so that we're familiar with the issues in it, and with that in mind, please
16 begin. You have about 20 minutes, sir.

17 MR. STOCKMAN: All right. Thank you, Your Honor. I don't intend to use
18 it all, and I have assumed all along you're quite familiar with the record.
19 I will just touch on the actual subject matter. And what I want to do is add a
20 few legal comments that weren't in our Brief that I think submit our position.
21 This is a case where the original rejections were under 102, and after we filed
22 our Appeal Brief, the Examiner dropped them completely because in his 102
23 rejections, he had basically just put in the abstract of the teachings of the
24 patent that did not apply to the claims. So in his Answer, he changed it to a
25 103 over two references, to Fritchie and Carbonari.

1 So rather than go back and reopen prosecution because we felt we had -- either
2 way we had reached an issue with the Examiner, we opted to respond
3 completely in our Reply Brief. The only thing that I felt -- and the Reply Brief
4 was written by a member of our firm that is no longer with us, but I had earlier
5 in the proceedings filed an amendment. I was familiar with the case. I'm fully
6 familiar with the record. So I just wanted to put that by way of background.
7 And just since you are familiar, I'd just point out our system is basically set
8 forth in Figure 1 where you have a service center and -- connected to a
9 plurality of automatic analyzing apparatuses used in a plurality of facilities.
10 Now, importantly, the service center has a database for storing analysis
11 parameters. And analysis parameters is important, too, because we get to that
12 in the only parts of the claim we're going to discuss. These parameters relate
13 to the plurality of the reagents for use in the apparatuses.
14 Now, it is our contention that the Examiner has not met his burden, and this is
15 the legal part. I just want to touch on it briefly. I'm sure you're all familiar
16 with it. But it is important to us that we just make a quick reference to it.
17 The Examiner has not met his burden of supporting a prima facie case of
18 obviousness. In KSR, the Supreme Court noted that an Examiner -- an
19 analysis by an Examiner supporting a 103 rejection should be made explicit
20 and they cannot -- the obvious rejection cannot be sustained with just
21 conclusionary statements and there must be reasoning and some rational
22 underpinning.
23 This, by the way, is stated very succinctly in Section 2142 of the Manual,
24 which I'm sure I don't have to call to Your Honors' attention. But I will say
25 this, and as stated in the Manual regarding obviousness, knowledge of an

1 application -- of an Applicant's disclosure must be put aside in reaching a
2 determination of obvious, although the Examiner still has to keep it in mind.
3 And in this case, we submit, respectfully, that the Examiner reached his
4 obviousness conclusion based on impermissible hindsight reached on the basis
5 of facts gleaned from Applicants' disclosure and not on the basis of the facts
6 gleaned from the prior art, which is what you're supposed to do.
7 I want to address my remarks primarily to Independent Claim 1 and just
8 certain parts of Independent Claim 1. And with respect to the dependent
9 claims, that is well covered in our Reply Brief, and I do not need to spend -- I
10 don't feel I need to spend time unless Your Honors have specific questions
11 about any of them.

12 Now, the preamble -- and this is important in this case. The preamble to Claim
13 1 recites an analysis information management method using the service center
14 connected to a plurality of automatic analyzing apparatuses used in the
15 plurality of facilities with a service center and, again, as I emphasized when I
16 started out, having a database for storing analysis parameters relating to the
17 reagents.

18 Now, the method includes various steps as set forth in Claim 1. I want to
19 focus on the steps right at the end, and the one step is calculating a statistical --
20 I have trouble with that word -- standard value -- my tongue gets tied up --
21 defined for the results of analyses on the control samples using the same
22 reagents in all automatic analyzing apparatuses.

23 And then another step, calculating a statistical deviation for the results of the
24 analysis from the standard value. And finally, determining whether the
25 analysis parameters in the analysis are correct based on the calculated
26 statistical deviation.

1 Now, with respect to the cited art of Fritchie and Carbonari, it is our position
2 that Fritchie, which relates only to the allocation of resources in a system,
3 basically he says at least two different machines, does not disclose or suggest
4 the steps of calculating a deviation between the results of an analysis and a
5 standard value of when a control sample is newly analyzed by an analyzing
6 apparatus or the step of using the results of this analysis to determine that the
7 analysis parameters used in the analysis are incorrect.

8 Now, just going -- the Examiner's reasons are set forth, we believe, in very
9 conclusionary terms. So I just want to touch on a couple.

10 With respect to the last step, the determination of whether the analysis
11 parameters are correct based on a calculated statistical deviation. On Page 3 of
12 his Answer, the Examiner asserts that Column 5, Lines 55 to 63, of Fritchie
13 disclose identification of the current reagent inventory in comparison with the
14 theoretical reagent map, which is said by the Examiner to meet the claim --
15 this is the Examiner -- claim limitations of storing database parameters relating
16 to reagents.

17 Now, as I've said earlier a couple of times, Applicants' Claim 1 actually states,
18 and that is why I said the analysis parameters are important, that the service
19 center has a database for storing analysis parameters relating to a plurality of
20 reagents and not database parameters relating to the reagents.

21 And that is critical because in Fritchie, he is not sending things using the --
22 excuse me one minute here -- sending the type of things here -- analysis
23 parameters are defined on Page 1 of our Specification as referring to
24 parameters for each testing item in the automatic analyzing apparatus and
25 basically includes information such as amount of the dispensed sample,
26 reagents used for the analysis and amounts thereof, the wavelength of

1 absorbents under measurement, the type of reaction process and so forth.
2 Now -- in the database, now, we do list the type of reagents, obviously, so
3 there is some similarity, but there is no indication in Fritchie of transferring
4 analysis parameters.

5 JUDGE KRATZ: Can I stop you there? In Fritchie, we don't even have a
6 service center that is connected to a plurality of facilities, if I'm not mistaken,
7 right?

8 MR. STOCKMAN: Absolutely, Your Honor. He is just trying to allocate --

9 JUDGE KRATZ: We have a plurality of instruments with a computer that is
10 used to allocate resources to those instruments, as I understand it. In other
11 words --

12 JUDGE PAK: So when you define the claimed service center, it precludes any
13 computer data that is used in the same premise as an automatic analyzer? Am
14 I correct?

15 MR. STOCKMAN: I'm not sure I understand your question, Your Honor.

16 JUDGE PAK: According to the Fritchie, it employs controller -- a computer --

17 MR. STOCKMAN: Yeah.

18 JUDGE PAK: -- which obtains the information and then uses that
19 information --

20 MR. STOCKMAN: Yeah, yes.

21 JUDGE PAK: -- to control the automatic analyzer?

22 MR. STOCKMAN: Right. But --

23 JUDGE PAK: That controller computer, because it is directly attached to
24 these analyzers as opposed to in a remote location, that that would distinguish
25 from the -- what is being called in the prior art?

1 MR. STOCKMAN: Absolutely correct, Your Honor. And thank you. I'm
2 sorry I didn't get your question at first but that is correct.
3 There are actually a lot of differences between the cited references. That is
4 why I basically wanted to stress the law, which I'm sure Your Honors are all
5 familiar with, that conclusionary statements, as the Examiner used, and one of
6 the reasons we didn't want to reopen prosecution -- and I don't mean to demean
7 the Examiner in the slightest.
8 Mr. Alexander, I'm sure, has got a lot of experience. But we just couldn't
9 reach an issue with him, and so we elected to bring our arguments here on
10 appeal. And I'm delighted to have the questions and point out things.
11 I only have one other point to make and that is on -- the Examiner did
12 acknowledge that Fritchie did not disclose calculating a statistical standard
13 value. So we appreciate that.
14 But then he cites Carbonari as disclosing that. Interestingly Carbonari
15 basically is directed to the improved efficiency of washing the end of a needle,
16 a transfer needle. And it is not concerned with the calculation of statistical
17 standard values, etc., etc., and the rest of the -- most of the patent is directed to
18 details of a construction.
19 And I just want to add -- make one quote. On Page 4, the Examiner cites
20 Column 4, Lines 10 to 18, of Carbonari as teaching -- and this is a quote --
21 Carbonari is teaching a built-in quality control system monitors the tests for
22 statistical deviation. All of these and other functions and parameters are
23 within the skill of those of ordinary skill in the art to implement.
24 That is the entire disclosure of Carbonari with respect to statistical deviations.
25 And we maintain that falls far short of the requirements of Claim 1. Frankly, it
26 is difficult to understand how the bare disclosure of no monitoring of tests for

1 statistical deviation can be used to teach a person of ordinary skill to calculate
2 the statistical standard value defined, etc., as we have defined in our claims. I
3 don't need to repeat that again.

4 JUDGE KRATZ: Does the Examiner even address that point?

5 MR. STOCKMAN: No. There are many things he didn't address. And again,
6 I don't mean to slight the Examiner at all, but we felt we had reached issue,
7 and these are really the points.

8 I just want to make one concluding sentence. The Examiner acknowledges
9 that Fritchie is silent as to the claimed step of calculating statistical -- I'll get
10 that word for you yet -- standard value. And Carbonari only discloses in
11 summary fashion that it is known to monitor tests.

12 We don't feel that he has made a *prima facie* case of obviousness, and that is
13 basically our case.

14 I'd be happy to answer any questions.

15 JUDGE GARRIS: No more questions, sir.

16 MR. STOCKMAN: Thank you, Your Honors, for your time.

17 JUDGE GARRIS: Thank you, Mr. Stockman, and, sir, you have a very good
18 day.

19 MR. STOCKMAN: Thank you, sir.

20 Whereupon, the proceedings at 9:51 a.m., were concluded.